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10/667,419	09/23/2003	Yuval Berenstein	2960/1	1092

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/667,419

**Applicant(s)**

BERENSTAIN ET AL.

**Examiner**

William P. Fletcher III

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 35-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of claims 1-34 in the reply filed on 27 OCT 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 35-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 27 OCT 2004.

### *Priority*

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Israel on 13 FEB 2003. It is noted, however, that applicant has not filed a certified copy of the IL 154452 application as required by 35 U.S.C. 119(b).

### *Specification*

4. The abstract of the disclosure is objected to because it recites neither the process steps for the making of the finished non-woven article nor the organization or operation of the machine/apparatus ("system") utilized in the manufacture of the non-woven article. Correction is required. See MPEP § 608.01(b).

5. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions,

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wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

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This claim is incomplete. As such, it is impossible to determine the metes and bounds of the subject matter of the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 19, 21, 23-25, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Frischer (US 5,989,380 A).**

With respect to claim 19, Frischer teaches a process for applying a variety of coatings to a non-woven fabric (abstract and 5:1-6:28). Since applicant defines a “finishing agent” as “any additive, coating, or colorant that may be added to non-woven fabric” (spec., 10:20-21), any one of these coatings anticipates applicant’s claimed “finishing agent.” The process comprises forming a continuous web of non-woven fabric and applying the finishing agent thereto as an in-line process (5:1-6:28).

With respect to claim 21, the exemplary web-forming process disclosed by Frischer anticipates applicant’s claimed wet-laid forming process (5:1-14).

With respect to claims 23 and 24, insofar as Frischer teaches that the web is dried after forming, this reference anticipates removing at least a portion of the production water of the wet-laid web (5:31-37).

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With respect to claim 25, insofar as Frischer teaches that a coating may be applied to the web by immersion (“dipping”), this reference anticipates applying the coating in a substantially uninterrupted fashion along the fabric (5:37-42).

With respect to claims 33 and 34, insofar as Frischer teaches that sublimable dyes (which also read on “finishing agents”) may be applied to the web in a desired design, this reference anticipates the subject matter of these claims (5:54-6:28).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. **Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frischer (US 5,989,380 A), as applied to claim 19 above, and further in view of Wang et al. (US 5,935,80 A).**

Frischer is relied upon here for the same reasons detailed above.

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While this reference does not explicitly state that the non-woven web may be formed by hydroentanglement or dry-laid (air-laid) processes, it does state that the non-woven web may be “produced by known and conventional papermaking techniques” (5:top).

Wang teaches that non-woven webs may conventionally be formed by wet-laid, air-laid (dry-laid), or hydroentanglement processes (1:18-40).

Because Frischer suggests that any conventional non-woven web-making process may be used and because Wang teaches that wet-laid, dry-laid, and hydroentanglement processes are all conventional non-woven web-making processes, it would have been obvious to one of ordinary skill in the art to modify the process of Frischer so as to utilize any one of these processes to manufacture the non-woven web. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully producing a non-woven web.

**14. Claims 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frischer (US 5,989,380 A), as applied to claim 19 above, and further in view of Jellinek et al. (US 4,810,751 A).**

Frischer is relied upon here for the same reasons detailed above. Specifically, this reference teaches that the finished non-woven web is suitable for use as a wall covering (i.e., wallpaper) and that the non-woven web is dipped into an acrylic binder to impart rigidity thereto and facilitate further processing thereof (5:38-47).

This reference does not explicitly state that the acrylic binder may be applied in the fashion or forms recited in these claims.

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Jellinek teaches that acrylic binder compositions may be applied to a variety of web substrates, including non-wovens, as a paste or foam, utilizing rotary screen printing or engraved rollers (4:27-51).

It would have been obvious to one of ordinary skill in the art to modify the process of Frischer so as to replace the immersion application of the acrylic binder with application as a paste or foam utilizing rotary screen printing or engraved rollers. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully applying the acrylic binder to the non-woven web.

**15. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frischer (US 5,989,380 A).**

Insofar as it is known to clean decorative wallpaper by washing with a detergent followed by drying and insofar as any coating reads on a finishing agent within the context of the claim (see above), the subject matter of this claim would have been obvious to one of ordinary skill in the art.

**16. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frischer (US 5,989,380 A), as applied to claim 19 above, and further in view of GB 2 292 082 A.**

Frischer is relied upon here for the same reasons detailed above. Again, this reference teaches that the finished non-woven web is suitable for use as a wall covering (5:38-47).

This reference does not explicitly state that application of the finishing agent includes applying a scent producing additive.



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The GB reference teaches that a scented coating may be applied to wallpaper to serve as an adhesive (abstract), the scent covering other unpleasant smells associated with application of the wallpaper (1:bottom).

It would have been obvious to one of ordinary skill in the art to modify the process of Frischer so as to add a scented coating to the wallpaper (said coating reading on a “finishing agent,” as discussed above). One of ordinary skill in the art would have been motivated to do so by the desire and expectation of yielding a wall covering with a pleasant smell.

**17. Claims 1, 2, 6-9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moroff et al. (US 4,324,832 A) in view of Lavigne (*The Pulp & Paper Dictionary*) and Dudley (US 4,089,765 A).**

Moroff teaches a process for the in-line coating of a formed, non-woven fabric (abstract; 1:10-50; and 3:49-4:61). As noted above, since applicant defines a “finishing agent” as “any additive, coating, or colorant that may be added to non-woven fabric” (spec., 10:20-21), any one of these coatings reads on applicant’s claimed “finishing agent.” Specifically disclosed are the coating apparatus and drying apparatus; the fabric and coating being dried together in the drying apparatus (4:1-2). Although this reference does not explicitly teach a step of forming the non-woven web, it is the examiner’s position that such a step is inherent because it is necessary to yield the web that is later processed according to the remainder of Moroff’s disclosure.

This reference does not teach applicant’s claimed moisture content.

Lavigne teaches that moisture content is a physical property of a web and that varies “according to atmospheric conditions because of the ability of [the web] to absorb or emit moisture (see attached definition of “moisture content”).

Further, Dudley teaches maintaining the moisture content of a non-woven web at a predetermined, wet (i.e., elevated) level to prevent buckling of the web during immersion coating (1:48-51), which is one of the coating processes exemplified by Moroff.

From these references, it is clear that the moisture content of a non-woven web is a physical property of which one of ordinary skill in the art would be acutely aware and which may be adjusted so as to give, for example, desirable web-handling characteristics during later processing. Consequently, moisture content is a result-effective variable. Absent clear and convincing evidence of unexpected results demonstrating the criticality of the claimed moisture content, it would have been obvious to one of ordinary skill in the art to modify the process of Moroff so as to optimize this result-effective variable by routine experimentation (see MPEP § 2144.05). It would have been further obvious to adjust the moisture content by any convenient means, including adding water (pre-wetting) or removing water (pre-drying) to/from the web.

With specific respect to claim 9, as noted above, insofar as Moroff teaches that a coating may be applied to the web by immersion, this reference anticipates applying the coating in a substantially uninterrupted fashion along the fabric (3:55-4:59).

With respect to claim 15, insofar as it is known to clean decorative wallpaper by washing with a detergent followed by drying and insofar as any coating reads on a finishing agent within the context of the claim (see above), the subject matter of this claim would have been obvious to one of ordinary skill in the art.

**18. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moroff et al. (US 4,324,832 A), Lavigne (*Pulp & Paper Dictionary*), and Dudley (US 4,089,765 A), as applied to claim 1 above, and further in view of Jellinek et al. (US 4,810,751 A).**

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Moroff, Lavigne, and Dudley are relied upon here for the same reasons detailed above.

None of these references explicitly state that the non-woven web is produced according to the processes recited in these claims.

Wang teaches that non-woven webs may conventionally be formed by wet-laid, air-laid (dry-laid), or hydroentanglement processes (1:18-40).

Because Moroff is silent with respect to how the non-woven web is produced, one of ordinary skill in the art would have looked to the prior art to find suitable non-woven web production processes. Because Wang teaches that wet-laid, dry-laid, and hydroentanglement processes are all conventional non-woven web-making processes, it would have been obvious to one of ordinary skill in the art to modify the process of Moroff, Lavigne, and Dudley so as to utilize any one of these processes to manufacture the non-woven web. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully producing a non-woven web.

**19. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moroff et al. (US 4,324,832 A), Lavigne (*Pulp & Paper Dictionary*), and Dudley (US 4,089,765 A), as applied to claim 1 above, and further in view of Wang et al. (US 5,935,880 A).**

Moroff, Lavigne, and Dudley are relied upon here for the same reasons detailed above. Specifically, Moroff teaches that the finished non-woven web is dipped into an acrylic resin as the finishing agent (4:3-5).

None of these references explicitly states that the acrylic binder may be applied in the fashion or forms recited in these claims.

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Jellinek teaches that acrylic binder compositions may be applied to a variety of web substrates, including non-wovens, as a paste or foam, utilizing rotary screen printing or engraved rollers (4:27-51).

It would have been obvious to one of ordinary skill in the art to modify the process of Moroff, Lavigne, and Dudley so as to replace the immersion application of the acrylic binder with application as a paste or foam utilizing rotary screen printing or engraved rollers. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully applying the acrylic binder to the non-woven web.

**20. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moroff et al. (US 4,324,832 A), Lavigne (*Pulp & Paper Dictionary*), and Dudley (US 4,089,765 A), as applied to claim 1 above, and further in view of GB 2 292 082 A.**

Moroff, Lavigne, and Dudley are relied upon here for the same reasons detailed above. Moroff teaches that the finished non-woven web is suitable for use as decorative paper (1:10-25 and 3:26-36).

None of these references explicitly states that application of the finishing agent includes applying a scent producing additive.

The GB reference teaches that a scented coating may be applied to wallpaper to serve as an adhesive (abstract), the scent covering other unpleasant smells associated with application of the wallpaper (1:bottom).

It would have been obvious to one of ordinary skill in the art to modify the process of Moroff, Lavigne, and Dudley so as to add a scented coating to the wallpaper (said coating reading on a "finishing agent," as discussed above). One of ordinary skill in the art would have

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been motivated to do so by the desire and expectation of yielding a wall covering with a pleasant smell.

21. **Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moroff et al. (US 4,324,832 A), Lavigne (*Pulp & Paper Dictionary*), and Dudley (US 4,089,765 A), as applied to claim 1 above, and further in view of Frischer (US 5,989,380 A).**

Moroff, Lavigne, and Dudley are relied upon here for the same reasons detailed above.

As noted above, Moroff teaches that the finished non-woven web is suitable for use as decorative paper (1:10-25 and 3:26-36). None of the cited references teach that a finishing agent containing a colorant is applied in a graphic pattern.

As noted above, Frischer teaches that sublimable dyes (which also read on “finishing agents”) may be applied to the web in a desired design to produce a decorative paper (5:54-6:28).

It would have been obvious to one of ordinary skill in the art to modify the process of Moroff, Lavigne, and Dudley so as to apply a graphic design as suggested by Frischer. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully yielding the desired decorative paper.

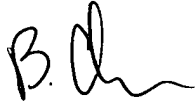
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**BRET CHEN**  
**PRIMARY EXAMINER**

*WPF 1/6/2005*  
William P. Fletcher III  
Examiner  
Art Unit 1762